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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,654	10/25/2001	Jens Erik Sorensen	52-162	7276

22653 7590 03/18/2005

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EXAMINER

PARDO, THUY N

ART UNIT	PAPER NUMBER
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2165

DATE MAILED: 03/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/980,654

Applicant(s)

SORENSEN ET AL.

Examiner

Thuy Pardo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2,3,32,35,39-48,67,69 and 77-94 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2,3,32,35,39-48,67,69 and 77-94 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Applicant's RCE and Amendment filed on February 28, 2005 in response to Examiner's Final Office Action has been reviewed. Claims 1, 4-31, 33, 34, 36-38, 49-66, 68, 70-76 have been canceled, claims 2, 32, 35, 39-46, 48, 69 have been amended, and claims 80-94 have been added.

2. Claims 2, 3, 32, 35, 39-48, 67, 69 and 77-94 are presented for examination.

#### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 2, 3, 32, 35, 39-48, 67, 69, and 77-94 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uchio et al. (Hereinafter "Uchio") US Patent Application No. US 2002/0019836 in view of Kossovsky et al. (Hereinafter "Kossovsky" US Patent Application No. US 2002/0002523.

As to claim 2, Uchio teaches a method of managing ideas [see the abstract], comprising:

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maintaining a computer database for accumulating ideas for prospectively patentable inventions, wherein said ideas include needs and requirements of said inventions [0216-0220 of page 11] and systematically establishing contractual obligation by contributors of said ideas to the database to transfer property rights to inventions derived at least in part from said accumulated ideas [0069 of page 3; 0059 of pages 2-3].

However, Uchio does not explicitly teach wherein said transfer is for contingent economic gain to said contractually obligated contributors. Kossovsky teaches online commercial network system designed to facilitate purchase and license exchange of IP assets [0075; fig. 5B, 10-12, 17C, 19-21; 0121].

Therefore, it would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to add the features of Kossovsky to the system of Uchio as an essential means to increase the efficiency and reliability of the system in determining an accurate market value for the patented technology and for secure transfer of intellectual property rights from the idea contributors to customers.

As to claim 69, all limitations of this claim have been addressed in the analysis above, and this claim is rejected on that basis.

As to claim 3, Uchio and Kossovsky teach the invention substantially as claimed. Uchio further teaches using at least one computer [0060 of page 3].

As to claim 32, Uchio and Kossovsky teach the invention substantially as claimed. Uchio further teaches systematically entering into said database all ideas contributed for entry into said database [ab; 0061-0062 of page 3].

As to claim 35, Uchio and Kossovsky teach the invention substantially as claimed. Kossovsky further teaches systematically entering into said database ideas contributed for entry into said database without requiring any contributor of said ideas to have subject matter expertise as a prerequisite for entry of said contributions [IP listed on the exchange in database, 0043 of page 2].

As to claim 39, Uchio and Kossovsky teach the invention substantially as claimed. Uchio further teaches requiring persons to enter into a membership as a prerequisite for viewing a portion of said database containing at least some of said accumulated ideas [0169 of page 9].

As to claim 40, Uchio and Kossovsky teach the invention substantially as claimed. Uchio further teaches requiring contributors of ideas for prospective entry into said database to enter into a membership as a prerequisite for contributing ideas for entry into said database [0147 of page 7].

As to claim 41, Uchio and Kossovsky teach the invention substantially as claimed. Uchio further teaches facilitating preparation and/or filing of patent applications for at least some inventions derived at least in part from said accumulated ideas [abstract].

As to claim 42, Uchio and Kossovsky teach the invention substantially as claimed. Kossovsky further teaches auctioning at least some right under the patent rights to at least some inventions derived at least in part from said accumulated ideas [ab; fig. 3-5].

As to claim 43, Uchio and Kossovsky teach the invention substantially as claimed. Uchio further teaches recording a time of receipt of each idea contributed for entry into said database [0089 of page 4].

As to claim 44, Uchio and Kossovsky teach the invention substantially as claimed. Uchio further teaches recording a time of publication in said database of each accumulated idea [fig. 30].

As to claim 45, Uchio and Kossovsky teach the invention substantially as claimed. Kossovsky further teaches recording a time of first public viewing from said database of each accumulated idea [fig. 12].

As to claim 46, Uchio and Kossovsky teach the invention substantially as claimed. Uchio further teaches providing contingent contractual rights to at least some inventions derived at least in part from said accumulated ideas [0112 of page 9].

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As to claim 47, Uchio and Kossovsky teach the invention substantially as claimed. Kossovsky further teaches enabling ideas contributed to said database to be integrated within said database to thereby facilitate derivation of inventions from said integrated ideas [ab].

As to claim 48, Uchio and Kossovsky teach the invention substantially as claimed. Kossovsky further teaches systematically establishing contractual obligations by contributors of said ideas to permit immediate public disclosure of said ideas contributed by said contributors [ab].

As to claim 67, Uchio and Kossovsky teach the invention substantially as claimed. Uchio further teaches that each step is performed systematically [fig. 2-4; 0016 of page 1].

As to claim 80, Uchio and Kossovsky teach the invention substantially as claimed. Kossovsky further teaches that contingent economic gain includes contingent contractual rights [0012].

As to claim 81, Uchio and Kossovsky teach the invention substantially as claimed. Kossovsky further teaches that contingent contractual rights include rights to a portion of anticipated income derived from property rights under the patent rights to prospectively patentable inventions derived at least in part from the ideas contributed by the contributors whom receive such contingent contractual rights [ab; 0005-0009; 0053; 0054; 0056-0061].

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As to claim 82, Uchio and Kossovsky teach the invention substantially as claimed. Kossovsky further teaches that contingent economic gain includes shares of a portfolio of contingent contractual rights [0044; 0099; 0011; ab].

As to claim 83, Uchio and Kossovsky teach the invention substantially as claimed. Kossovsky further teaches that contingent economic gain includes shares of stock in a proprietor of said database or a party in concert with the database proprietor [0075; 0076; 0095; 0121].

As to claim 84, Uchio and Kossovsky teach the invention substantially as claimed. Kossovsky further teaches that step (c) is in exchange for acquiring or facilitating transfer of at least some said property rights [0053; 0054; 450 of fig. 4]

As to claims 77-79 and 85-94, all limitations of these claims have been addressed in the analysis above, and these claims are rejected on that basis.

### ***Response to Arguments***

4. Applicant argues that neither Uchio nor Kossovsky teach requiring the contingent economic gain be provided to contributors of ideas.

As to point this, Examiner respectfully disagrees. Kossovsky teaches online commercial network system designed to facilitate purchase and license exchange of intellectual property assets between the idea contributors and their customers. Kossovsky teaches the amount of



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money (of selling a patent) must be spent by the owner of the patent in order to turn the raw technology into a commercial product [see 0075; 0121].

Applicant argues that Uchio does not teach establishing contractual obligations.

Examiner respectfully disagrees. Examiner believes that this feature has been taught by Uchio. Uchio teaches a plurality of external companies 111 for cooperatively perform research and development with the enterprise group 110 [see fig. 1]. They manage the products of the cooperative research and development based on the mutual contract and patent rights [0069 of page 3]. Examiner also believes that the contractual obligations are inherent established based on the mutual contract and patent rights among a plurality of external companies and the enterprise group. Uchio also teaches using a computer system for systematically managing this feature [obligations for a staff, fig. 25; obligations for the supervisor of staffs, fig. 26].

Applicant argues that Uchio does not teach systematically entering into said database all ideas contributed for entry into said database.

Examiner respectfully disagrees. Uchio teaches inputting patent applications to the system's database [S1903 of fig. 19].

Applicant argues that the cited references do not teach the feature of without requiring any contributor of said ideas to have subject matter expertise as a prerequisite for entering ideas into said database.

Examiner respectfully disagrees. Although neither Uchio nor Kossovsky explicitly teach the feature of without requiring any contributor of said ideas to have subject matter expertise as a prerequisite for entering ideas into said database, the feature is inherent in the intellectual property management system. For example, patent applications (or idea applications) can be

entered into the database system by the LIEs (Legal Instrument Examiners) or by the contractors who need not have subject matter expertise of said ideas.

Applicant argues that Uchio does not teach entering into a membership as a prerequisite for viewing or contributing invention ideas.

As to this point, Examiner respectfully disagrees. Examiner believes that this feature is taught by Uchio. Uchio teaches assigning serial number and registration number for every invention applications for viewing and contributing invention ideas [see fig. 30, 33]. Kossovsky also teaches this feature [see fig. 16A].

Applicant argues that Uchio does not teach facilitating preparation and/or filling of patent applications for at least some inventions derived at least in part from ideas accumulated in the database. Examiner respectfully disagrees. Uchio teaches that information related to a patent application is accumulated in a database and facilitating preparation and/or filling of patent applications for at least some inventions derived at least in part from ideas accumulated in the database [ab; S1505, S1508].

Applicant argues that Uchio does not teaches recording the time of receipt, publication, or viewing of each idea. Examiner respectfully disagrees. Examiner believes that this feature is taught by Uchio. Uchio teaches recording the time of receipt, publication, or viewing of each idea [fig. 30; 0089 of page 4].

Application argues that Kossovsky does not explicitly teach auctioning at least some right under patent rights to at least some inventions derived at least in part from said accumulated ideas. As to this point, Examiner respectfully disagrees. Kossovsky teaches auctioning at least some right under patent rights to at least some inventions derived at least in part from said

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accumulated ideas [see fig. 3-5] in order to transfer the IP rights to the highest bid buyer [0051-0053 of page 3].

Applicant argues Kossovsky does not teach permitting immediate public disclose of said ideas. As to this point, Examiner respectfully disagrees. Kossovsky teaches permitting immediate public disclose of said ideas by auctioning IP assets online [see ab; fig. 3-5; 0051-0054 of pages 3-4; 0060-0062 of page 5].

5. Applicant's arguments filed on February 28, 2005 have been fully considered but they are not persuasive.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy Pardo, whose telephone number is 571-272-4082. The examiner can normally be reached Monday through Thursday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici, can be reached at 571-272-4083.

The fax phone number for the organization where this application or proceeding is assigned are as follows:

(703) 872-9306 (Official Communication)

and/or:

***571-273-4082 (Use this Fax#, only after approval by Examiner, for "INFORMAL" or "Draft" communication. Examiner may request that a formal/amendment be faxed directly to then on occasions).***

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Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

**7. Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 308-9051, (for formal communications intended for entry)

**Or:**

(703) 308-5359, (for informal or draft communications, please label

"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121

Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

March 10, 2005



**THUY N. PARDO**  
**PRIMARY EXAMINER**